

Remarks/Arguments

Claims 2 to 6, 13 and 14 are pending. Claims 2, 3 and 5 have been amended. Claims 12 and 21 are hereby cancelled.

Applicants have concurrently filed herewith an executed terminal disclaimer over U.S. Patent No. 6,726,363.

The Office Action stated:

"Specification"

"The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use."

"Arrangement of the Specification"

"As provided in 37 CFR 1. 77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase 'Not Applicable' should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED
RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH
AGREEMENT

- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), 'Sequence Listings' (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A 'MICROFICHE APPENDIX' (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
- (1) Field of the Invention.
- (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A 'Sequence Listing' is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and

if the required 'Sequence Listing' is not submitted as an electronic document on compact disc)."

[Emphasis supplied]

The disclosure has been objected to because of the following informalities: The section headings are missing. Applicants traverse this objection and statement because there is not any mandatory requirement that the specification contain any headings, let alone the above-recited ones.

The Office Action stated that appropriate correction is required. Applicants traverse this statement as being incorrect. Headings are not required in the specification:

Rule 177(b) states:

"The specification should include the following sections in order:

* * *."

[Emphasis Supplied]

Rule 177(c) states:

"The text of the specification sections defined in paragraphs (b)(1) through (b)(12) of this section, if applicable, should be preceded by a section heading in uppercase and without underlying or bold type."

[Emphasis Supplied]

The term "should" is not mandatory. Headings are optional, but preferred. However, to advance the prosecution of this application, applicants have inserted the appropriate headings.

This objection should be withdrawn.

The Office Action stated that the following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 12 and 21 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The Office Action stated that regarding Claim 3, the term “and/or” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

This matter has been corrected in Claim 3.

The Office Action stated: that Claim 12 provides for the “process of utilizing” of a packing with a tear aid and sealed edges to hold liquid, pasty, powdery, granulated or solid filings, but, since the claims does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass; and that a claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Applicants traverse this statement. The term “utilizing” is an action verb that forms an active, positive step with a limitation of “to hold...”. The defined packing from laminate material of Claim 13 is being utilized “to hold liquid...” is not indefinite. However, to advance the prosecution of this application, applicants have cancelled Claim 12.

The Office Action stated: that Claim 21 is indefinite because it depends from cancelled Claim 1; and that, for purposes of examination, Claim 21 will be considered as dependent from independent Claim 13. Claim 21 has been cancelled.

This rejection should be withdrawn.

Claim 12 has been rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. Applicants traverse this rejection and statement.

As shown above, applicants have shown that the Claim 12 recites a step in the process with a defining limitation.

The Office Action stated see, for example, *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967), and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Neither of these decisions is relevant since they only deal with the term "use" that is a noun in the involved claims. Neither deals with the term "use" as an action verb. Furthermore, the Examiner's apparent interpretation of such decisions, and the decisions themselves, are incorrect and in error. 35 U.S.C. 100 states:

"When used in this title...:

(b) The term 'process' means process,...., or method, and includes a new use of a known,..."

[Emphasis Supplied]

However, to advance the prosecution of this application, applicants have cancelled Claim 12.

This rejection should be withdrawn.

The Office Action stated:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claims is not patentably distinct from the reference claim(s) because the examined application claims is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ

619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims in invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The above-statement of the Office Action, even though it is a quotation of Form paragraph 8.33 of the M.P.E.P., is clearly incorrect and in direct conflict with the statute, decisional law and the M.P.E.P. If anticipation is involved, then statutory double patenting based on 35 U.S.C. 101 has to be involved, not obviousness-double patenting. However, no anticipation is involved as shown as below.

Claims 13 and 14 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 2 of U.S. Patent No. 6,726,363. Applicants disagree with this rejection.

Chart II-A in Section 804 of the M.P.E.P. deals with the "SAME INVENTION" [Emphasis Supplied], with the "Same Inventive Entity", (involving "CONFLICTING CLAIMS BETWEEN AN APPLICATION AND A PATENT"), and

states that the rejection is a “Statutory Double-Patenting Rejection” [Emphasis Supplied].

Section 804.II.A. states: “Same invention” means identical subject matter.” [Emphasis Supplied]

Chart II-B in Section 804 of states “DIFFERENT INVENTIONS (Not Patently Distinct)”

Applicants’ Claim 13 states:

“..., a longitudinal back seam (23), formed by overlapping two longitudinal edges of the laminate material, on the second side, ...[Emphasis Supplied].

Claim 1 of U.S. Patent No. 6,726,363 states:

“..., longitudinal back seam (19) formed by several layers of the laminate material, on the second side, ...” [Emphasis Supplied]

Hence, Claim 1 (and Claim 2) of U.S. Patent No. 6,726,363 is not drawn to the “identical subject matter” as claimed in the applicants’ claimed invention. U.S. Patent No. 6,726,363 does not claim a longitudinal seam specifically being formed by overlapping two longitudinal edges of the laminate. Hence, U.S. 6,726,363 does not anticipate even Claim 12.

The Office Action stated: that applicants’ arguments filed 06/23/2006 have been fully considered but they are not persuasive; that, regarding the rejection Claims 13 and 14 on the ground of nonstatutory obviousness-type double patenting, applicants argued that the Examiner has not made any Graham

factual inquiries in the record and therefore the obviousness double-patenting rejection is incorrect; that applicants' further remarks that, if the claims of U.S. Patent No. 6,726,363 anticipate Claims 13 and 14 of the present application, this would not be an obviousness double-patenting rejection, that the Examiner maintains that the anticipation of U.S. Patent No. 6,726,363 in rejecting Claims 13 and 14 in the an obviousness double-patenting rejection is proper; that "A later patent claims is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim; and cited In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patent because the claims at issue were obvious over claims in four prior art patent); In re Berg, 140 F.3d at 1437, 46 USPQ 2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED" May 30, 2001). Applicant disagree with the Examiner's position and refer the Examiner to the portions of the M.P.E.P cited below. If there is anticipation, then there cannot be obviousness-type double patenting. However, anticipation is not involved.

The Office Action stated that, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of U.S. Patent No. 6,726,363 contain every element of Claims 12 to 14 of the present application and as such anticipates Claims 12 to 14 of the present

applicant. Applicants traverses this statement because it is inherently at conflict with itself. Since the "claims are not identical", as per the Examiner, they cannot be anticipated by the claims of U.S. Patent No. 6,726,363. Under Section 2131 of the M.P.E.P. dealing with anticipation, there is no anticipation of any of applicants' claims because the "identical invention must be shown".

To advance the prosecution of this application, applicants have concurrently filed herewith an executed terminal disclaimer over U.S. Patent No. 6,726,363.

This rejection should be withdrawn.

Claims 2 to 6, 12 and 21 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 2 of U.S. Patent No. 6,726,363. Applicants disagree with this rejection.

The Office Action stated that, although the conflicting claims are not identical, they are not patentably distinct from each other. Applicants disagree with this statement.

The Office Action stated: that regarding Claims 2 and 21, U.S. Patent No. 6,726,363 discloses the claimed invention, especially the weakened zones lying in a line in the area of the edge border or sealed border; that, however, U.S. Patent No. 6,726,363 does not disclose the weakened zones having a width of 5 to 20 mm; that it would have been an obvious matter of design choice to make the weakened zones, of U.S. Patent No. 6,726,363, 5 to 20 mm wide, since such a modification would have involved a mere change in the size of a component; and that a change in size is generally recognized as being within the level of

ordinary skill in the art. Applicants disagree with this statement. The Examiner has not factually determined in the record the level of ordinary skill in the art, as required by Section 804.B.1, of the M.P.E.P. The Examiner also has not proven in the record, and cannot know, what would be generally recognized as being within the level of ordinary skill in the art (because he has not factually proven in the record, as required, the level or ordinary skill in the art).

The last 6 lines on page 5 of the Office Action ends in an incomplete sentence. Completion thereof is requested.

The Office Action stated: that, regarding Claim 3, U.S. Patent 6,726,363 discloses the claimed invention, especially each weakened zone having a multiplicity of lines of cuts; that, however, U.S. Patent No. 6,726,363 does not disclose the number of lines of cuts being four; and that it would have been an obvious matter of design choice to make the weakened zones with four lines of cuts in U.S. Patent No. 6,726,363, since applicants have not disclosed that four lines of cuts solves any stated problem or is for any particular purpose and it appears [?]. Applicants disagree with the statement. The Examiner has not even stated to whom such would be “an obviousness of design choice”.

The Office Action stated: that regarding Claim 4, U.S. Patent No. 6,726,363 discloses the claimed invention except for the weakened zones being parallel to the transverse edge border or sealed edge borders and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the weakened zones of U.S. Patent No 6,726,363 such that they are parallel to the transverse edge border or sealed edge border, since it

has been held that rearranging parts of an invention involves only routine skill in the art. Applicants disagree with this statement because, for example, the Examiner does not know anything regarding one ordinarily skilled in the art (because he has not determined what was the level in the art).

The Office Action stated that, regarding Claim 5, each weakened zone having a multiplicity of parallel rows of individual uninterrupted lines cuts in U.S. Patent No. 6,726,363 meets the recitation "each of the weakened zones are cut sequences". The Examiner has not shown the existence of obviousness of any of applicants claims over U.S. Patent No. 6,726,363.

The Office Action stated that, regarding Claim 6, each weakened zone being located in the same or different material of the laminate material in U.S. Patent No. 6,726,363 meets the recitation "at least one material of the laminate material has no weakened zones and at least one material layer of the laminate material has weakened zones". Applicants disagree with this statement as the Examiner has not factually proven in the record that which is required by M.P.E.P.

The Office Action stated regarding Claim 12, the recitation "A combination of the packing (16) according to Claim 1, with liquid, pasty, powdery, granulated or solid filing [sic] in internal cavity (21) of the packing (16)" in Claim 21 of U.S. Patent No. 6,726,363 meets the claimed "process of utilizing" to the same degree that the claim can be understood. The claim can be understood by the Examiner because he readily corrected spelling in the claim in his quotation. Claim 12 has been cancelled.

To advance the prosecution of this application, applicants have concurrently filed herewith an executed terminal disclaimer over U.S. Patent No. 6,726,363.

This rejection should be withdrawn.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

Nov. 16, 2006
Date

Virgil H. Marsh
Virgil H. Marsh
Reg. No.: 23,083

Fisher, Christen & Sabol
Suite 1108
1725 K Street, N.W.
Washington, D.C. 20006
Tel.: 202 659-2000
Fax: 202 659-2015

